

REMARKS/ARGUMENTS

Claims 1-6, 9-21 and 25-30 are active.

The claims in this application are directed to alkynyl aryl carboxamide compounds as well as methods of treating or preventing at least one disease selected from seven specific disorders (see Claim 1).

Applicants appreciate the determination that the elected specie, that is Example 36 on page 105, is allowable and that the compound claims, composition claims and methods of making those compound claims are allowable but for the inclusion of the non-elected subject matter. The claims have been amended to define the elected subject matter with the recognition that the non-elected, cancelled subject may be pursued in one or more divisional applications.

No new matter is believed to have been added.

To the claims not currently deemed allowable, Claims 1-6, 9-11 and 25-30, which are the method claims involving the treatment and/or prevention of the specific disorders listed, are rejected as allegedly failing to comply with the enablement requirement.

The Examiner notes that Example 1 is tested and shown to possess PTP1B inhibiting activity but it is unclear whether the other examples were similarly tested (see page 4 of the Action).

As a first point, the conclusions provided in the Action have no basis and not backed by evidence as required under US law. In re Lee, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002) (“ ‘The factual inquiry whether to combine references must be thorough and searching.’...It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with.”). The Examiner has

not cited to nor provided any factual basis as to why the conclusions in the Action are meritorious.

Nonetheless, Applicants submit that the specification does provide an enabling disclosure. The examples starting on page 175 indicate that Examples 2, 16, 68 and 76 have activity in the *in vitro* assay described starting at page 174. These tests show an IC₅₀ with respect to PTP-1B of less than 1 μ M. These results are disclosed on page 175 to 176 as being representative examples of the tested examples. These Examples demonstrate that a key structural feature for the PTP-1B is activity is the presence of the Cy-A moiety where Cy is an aryl and A is an alkyne or an arylalkyne. The other substituents provide slight variations of the biological activity therefore allowing some structural diversity. The differences of the R3, R4 and R5 groups of the specific examples are representative of the differences of all of the examples and clearly shows that compounds of the other examples are able to shown an activity toward PTP-1B, in particular an activity lower than 20 μ M as discussed on page 175, lines 14-16 of the present application.

Thus, the evidence shown in the specification provides sufficient guidance to allow one to make and/or use the compounds for the claimed methods without undue experimentation as such experimentation to one of ordinary skill in the art, which skill level is high, is routine in the art.

For these reasons, withdrawal of the rejection is requested.

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Reply to Official Action of November 5, 2008

A Notice of Allowance for all pending claims is requested.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



Daniel J. Pereira
Attorney of Record
Registration No. 45,518

Customer Number

22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 06/04)
CJA:law